

04-29-02

636

EXPRESS MAIL CERTIFICATE

4/26/02 028722768US

Date Label No.

I hereby certify that, on the date indicated above, this paper or fee was deposited with the U.S. Postal Service & that it was addressed for delivery to the Assistant Commissioner for Patents, Washington, DC 20231 by "Express Mail Post Office to Addressee" service.

PLEASE CHARGE ANY DEFICIENCY UP TO \$300.00 OR CREDIT ANY EXCESS IN THE FEES DUE WITH THIS DOCUMENT TO OUR DEPOSIT ACCOUNT NO. 04-0100

#9



Name (Print)

Signature

Customer No.:



07278

PATENT TRADEMARK OFFICE

Docket No: 0630/1E791US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Vedrana S. SUSULIC; Emir DUZIC

Serial No.: 09/761,116

Art Unit: 1636

Confirmation No.: 3094

Filed: January 16, 2001

Examiner: G. Leffers, Jr.

For: TRANSCRIPTIONAL REGULATION OF THE HUMAN BETA3 - ADRENERGIC RECEPTOR GENE

-----

RESPONSE TO RESTRICTION REQUIREMENT

Hon. Commissioner of  
Patents and Trademarks  
Washington, DC 20231

April 26, 2002

Sir:

In response to the Restriction Requirement dated March 26, 2002, please consider the following remarks. The time set for this response is April 26, 2002.

## Restriction Requirement

The Examiner has required restriction to one of the following four Groups under 35 U.S.C. § 121:

- Group I: Claims 1-21, drawn to nucleic acids and host cells comprising the nucleic acids;
- Group II: Claim 22, drawn to a  $\beta_3$ -AR trans-activating factor polypeptide;
- Group III: Claims 23-27, drawn to methods of isolating a polypeptide that binds specifically to a nucleic acid comprising SEQ ID NO: 1; and
- Group IV: Claims 28-37, drawn to methods of identifying a compound that modulates the activity of a  $\beta_3$ -AR trans-activating factor polypeptide.

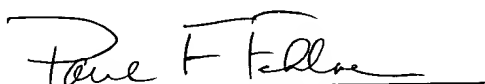
In the Office Action, the Examiner contends that Group I and Group II are distinct, and capable of supporting separate patents. The Examiner also contends that Group I and Groups III-IV are patently distinct in that Group I comprises a product that can be made by other processes, in either Group III or IV. The Examiner uses the same argument for the polypeptide of Group II which can be used in either Groups III or IV. Finally, the Examiner contends that Groups III and IV are biologically and functionally different and distinct where the end results of the two groups are different.

Applicants respectfully submit that most of the claims of Group I (claims 3-21) were cancelled when the application was filed. These claims have since been prosecuted to issuance in the parent application.

The Applicants hereby elect, without traverse, to prosecute the claims of Group IV (claims 28-37), directed to methods of identifying a compound that modulates the activity of a  $\beta_3$ -AR trans-activating factor polypeptide.

Prompt and favorable examination of the elected claims is earnestly solicited.

Respectfully submitted,



Paul F. Fehlner, Ph.D.

Reg. No. 35,135

Attorney for Applicants

DARBY & DARBY, P.C.  
Post Office Box 5257  
New York, NY 10150-5257  
Phone (212) 527-7700